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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/053,015	11/09/2001	Bruce Edwards	005532.P015	8665
7590	05/19/2004			EXAMINER DANG, HUNG Q
Archana B. Vittal BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP Seventh Floor 12400 Wilshire Boulevard Los Angeles, CA 90025-1026			ART UNIT 2635	PAPER NUMBER 9
			DATE MAILED: 05/19/2004	

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/053,015	EDWARDS ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Hung Q Dang	2635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 19 November 2001.  
2a)  This action is **FINAL**.                    2b)  This action is non-final.  
3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 1-12 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5)  Claim(s) \_\_\_\_\_ is/are allowed.  
6)  Claim(s) 1-12 is/are rejected.  
7)  Claim(s) 4 and 9 is/are objected to.  
8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on 02 July 2002 is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 8.  
4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_.

## DETAILED ACTION

### ***Claim Objections***

**1. Claims 4 and 9 are objected to because of the following informalities:**

Claims 4 and 9 contains the terms "capable of". It has been held that the recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. Therefore, the claimed limitation "...the transmitted signals capable of traveling through a light pipe embedded within the entertainment device and aligned with the remote controller infrared transmitter when the remote controller is coupled with the entertainment device", in claims 4 and 9, will not be given any patentable weight. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

**2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:**

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**3. Claims 7 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Koide U.S. Patent 4,450,487.**

**Regarding claim 7**, Koide teaches a detachable remote controller comprising:

An infrared transmitter located at one end of the detachable remote controller to transmit signals to an electronic entertainment device while the detachable remote controller is not coupled with the entertainment device (column 8 lines 3-7); and

Exposed metal contacts (Figure 3, units 72) to physically contact corresponding metal tabs (Figure 3, units 74) on the entertainment device so that a wired communication line is established between the detachable remote controller and the entertainment device, the exposed metal contacts physically contacting the corresponding metal tabs while the detachable remote controller is docked within a cavity and flush with a surface of the entertainment device (Figure 5 and paragraph bridging columns 7-8).

**Regarding claim 8**, Koide also discloses a set of control buttons to trigger specified signals to be transmitted by the infrared transmitter (column 4, lines 40-50).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-6 and 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koide U.S. Patent 4,450,487 in view of Arai U.S. Patent 5,486,852.

**Regarding claim 1**, as mentioned above, Koide teaches a detachable remote controller comprising an infrared transmitter located at one end of the detachable remote controller to transmit signals to an electronic entertainment device while the detachable remote controller is not coupled with the entertainment device;

However, Koide teaches exposed metal contacts to electrically connect said remote controller to said entertainment device while the detachable remote controller is docked within a cavity and flush with a surface of the entertainment device **instead of** using an second infrared transmitter being aligned in the cavity such that said IR transmitter transmits signals to a light pipe embedded within the entertainment device when said remote controller is coupled with said entertainment device.

Arai, in the same field of endeavor, teaches a detachable remote controller (Figure 7, unit 41), which **alternatively** employs an IR transmitter (Figure 7, unit 26) being aligned in the cavity such that said IR transmitter transmits signals to a light pipe (Figure 7, unit 48) embedded within the entertainment device when said remote controller is coupled with said entertainment device (column 5, lines 14-26).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to alternatively provide another IR transmitter

(to the remote controller) to transmit signals (from the remote controller) to a light pipe embedded within the entertainment device when the remote controller is coupled to said entertainment device disclosed by Koide, as suggested by Arai, in order to transmit control signals from said remote controller to said entertainment device.

**Regarding claim 2**, the remote controller disclosed by Koide also includes exposed metal contacts (Figure 3, units 72) to physically contact corresponding metal tabs (Figure 3, units 74) on the entertainment device so that a wired communication line is established between the detachable remote controller and the entertainment device, the exposed metal contacts physically contacting the corresponding metal tabs while the detachable remote controller is docked within a cavity of the entertainment device (Figure 5 and paragraph bridging columns 7-8).

**Regarding claim 3**, Koide also teaches a set of control buttons to trigger specified signals to be transmitted by the IR transmitter (column 4, lines 40-50). And since Koide in view of Arai teaches a second IR transmitter to the remote controller to transmit signals to the entertainment device while said remote controller is coupled to said entertainment device, it would have been obvious to one of ordinary skills in the art to provide control buttons to trigger specified signals to be transmitted by **both** the infrared transmitters in order to control said entertainment device while said remote controller is **coupled or detached** from said entertainment device.

**Claims 4-5 and 9-11** are rejected for the same reasons as claim 1.

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**Regarding claims 6 and 12,** Koide also discloses a set of control buttons to trigger specified signals to be transmitted by the infrared transmitter (column 4, lines 40-50).

### Conclusion

6) Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hung Dang whose telephone number is 703-305-1836. The examiner can normally be reached on Monday through Friday from 8:30AM to 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Horabik, can be reached on (703) 305-4704. The fax phone number for the organization where this application or proceeding is assigned is 703872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Hung Dang

5/12/2004

H. D.

*HD*

MICHAEL HORABIK  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600

